

Serial No. 10/726,973  
Attorney Docket No. 24170759.3

### REMARKS/ARGUMENTS

The Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and the following remarks/arguments. Claims 1-27 were originally filed with the present Application, and are all rejected in the pending Office Action. In the present Amendment, the Applicant has amended claims 1, 2, 4, 10, 11, 13, 19, 20 and 22, and have canceled claim 6. No claims have been added, and no new matter has been added by the amendments. Accordingly, claims 1-5 and 7-27 remain pending in the present Application.

#### **I. OBJECTIONS**

The Examiner has objected to the drawings as not disclosing certain designators mentioned in the specification. Specifically, several features of the invention(s) having individual components have been described in some places in the specification under a single designator number. In response, the Applicant has amended the relevant portions of the specification to remove the single designator numbers as they are not necessary to understand the invention(s) or the drawings. Accordingly, the Applicant respectfully request that these objections be withdrawn.

The Examiner has also objected to claim 6 under 37 C.F.R. 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Examiner states that claim 6 is dependent from claim 1, but that claim 1 already discloses that carriages are used to couple the first and second arms to the base and the first arm. In response, the Applicant has canceled claim 6 without prejudice or disclaimer. Accordingly, the Applicant respectfully requests that the objection to claim 6 be withdrawn.

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## II. REJECTIONS UNDER 35 U.S.C. §112

The Examiner has rejected claims 1-27 under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner has rejected the pending claims all on similar grounds, namely, that it is unclear what structure allows the entire extending arm to rotate about the second rotational axis. In response, the Applicants have amended claims 1, 2, 4, 10, 11, 13, 19, 20 and 22 to more clearly recite that the extending arm includes a central shaft 46, and the central shaft 46 rotates within the second arm about the second rotational axis. In view of these amendments, the Applicant requests that these rejections be withdrawn.

## III. REJECTIONS UNDER 35 U.S.C. §103

The Examiner has rejected claims 1-27 under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 4,662,117 to Korwin *et al.* in view of U.S. Patent No. 6,764,385 to Boumerzoug *et al.* In response, the Applicant respectfully asserts that the combination of Korwin with Boumerzoug in an effort to arrive at all the elements recited in independent claims 1, 10 and 19 is improper, and also fails to teach or suggest all of the elements recited in these independent claims.

As the Examiner admits, Korwin does not teach or suggest a second arm pivotally coupled to the first arm via a second carriage, as recited in independent claims 1, 10 and 19. As a result, the Examiner seeks to combine Korwin with Boumerzoug to arrive at this feature recited in the present claims. The Korwin apparatus has been provided with a pivoting "spindle head" 34 mounted within a yolk 36 at the end of the ram 32 in order to direct the positioning of a tool along this rotational axis in the manner described. Col. 3, ln. 50, to col. 4, ln. 10. Since Korwin already includes a specific means by which this pivoting positioning of a tool may be provided,

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there is nothing in Korwin that would suggest the need for further including the pivotal device 36 in Boumerzoug, and to do so would obviate the need for the pivoting means already provided by Korwin. In order to properly combine references for a rejection under 35 U.S.C. §103, it is not enough that a combination may be possible. Instead, there must also be some motivation to combine the two references provided in the knowledge held by one of ordinary skill in the art or found in the references themselves. Here, because Korwin already provides a pivoting device sufficient for positioning the tool as desired, there is no motivation to combine the pivotal device 36 of Boumerzoug with the apparatus of Korwin. Since there is no motivation for the combination offered by the Examiner, the combination is improper and cannot serve as the basis for a rejection of the pending claims under 35 U.S.C. §103. Accordingly, the Applicant respectfully requests that the Examiner withdraw the §103 rejection with respect to the pending claims.

Moreover, the positioning device of Korwin also doesn't not disclose a central shaft configured to rotate within the second arm about a second rotational axis parallel to the vertical axis, as recited in independent claims 1, 10 and 19. Specifically, Korwin discloses a ram 32 configured only for vertical movement along a vertical axis. Col. 2, lns. 58-60. However, there is no central shaft provided within this ram 32 for rotational movement about this vertical axis. Instead, only the yoke 36 discussed above is configured for swivel (i.e., rotational) movement with respect to the ram 32. Col. 2, lns. 60-65. Furthermore, there is also no such central shaft disclosed in Boumerzoug. Thus, Korwin, alone or in combination with Boumerzoug, also does not teach or suggest a central shaft configured to rotate within the second arm about a second rotational axis parallel to the vertical axis, as recited in independent claims 1, 10 and 19. For this

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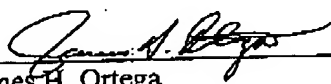
reasons as well, the Applicant respectfully requests that the Examiner withdraw the §103 rejection with respect to the pending claims.

#### IV. CONCLUSION

The Applicant respectfully submits that pending claims 1-5 and 7-27 are in condition for allowance, and request a Notice of Allowability for the pending claims. The Examiner is invited to contact the undersigned Attorney of Record if such would expedite the prosecution of the present Application. Although no fees are believed to be due with this Amendment, if it is determined that fees are due, please charge or credit Deposit Account No. 13-0480, referencing the Attorney Docket Number specified herein.

Respectfully submitted,

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